

**UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513**

Lykos

Mailed: June 22, 2004

Opposition No. 91115866

Cancellation Nos. 92028126;
92028127; 92028130; 92028133;
92028145; 92028155; 92028171;
92028174; 92028199; 92028248;
92028280; 92028294; 92028314;
92028319; 92028325; 92028342
and 92028379

**Prairie Island Indian
Community, Plaintiff**

v.

**Treasure Island Corp.,
Defendant**

(as consolidated)¹

Angela Lykos, Interlocutory Attorney

This case now comes up for consideration of defendant's motions to (1) "define the scope of [plaintiff's] waiver of the attorney-client privilege, including clarifying [plaintiff's] prior waiver of the privilege;" (2) compel plaintiff to produce documents that had been improperly withheld based on the attorney-client privilege; (3) prohibit Mr. William Hardacker, plaintiff's former counsel,

¹ Parties are reminded that their submissions should be captioned in the above manner with Opposition No. 9111866 as the parent case in this consolidated proceeding.

from invoking the attorney-client privilege to avoid deposition; (4) extend discovery; (5) determine the sufficiency of plaintiff's responses to requests for admissions; (6) compel supplemental responses to interrogatories; and (7) compel production of documents. Except for the motion to extend discovery, the motions are contested. In addition, plaintiff has filed a motion for the Board to issue a show cause order why defendant's allowance of cancellation of certain registrations under Section 8 should not result in judgment against defendant.

The Board has carefully reviewed the parties' respective arguments and accompanying exhibits, although the Board has not repeated the parties' complete arguments in this order.

Relevant Background

Prior to being represented by its current legal counsel, plaintiff retained two other law firms, Merchant & Gould and Dorsey & Whitney. On May 8, 2002, the Board issued an order in which it considered defendant's motion to compel production of all correspondence "from or to Merchant & Gould (plaintiff's former counsel) regarding the TREASURE ISLAND mark." The Board found that as to the subject matter of the registerability of plaintiff's mark in 1992, plaintiff had waived the attorney-client privilege by consenting to the production of two letters dated April 15

and April 22, 1992 which were drafted by plaintiff's former attorney at Merchant & Gould, and discussing the letters during a contemporaneous discovery deposition. In connection with defendant's motion to compel, plaintiff submitted six additional letters which it claimed were privileged for *in camera* inspection by the Board. In order to determine the scope of the waiver of the attorney-client privilege, the Board applied the rule that a voluntary waiver by a party, without limitation, of one or more privileged documents discussing a certain subject, waived the privilege as to all communications between the same attorney and the same client on the same subjects. Applying this standard, the Board reviewed each document and made a ruling as to the scope of the waiver.

Defendant's Motion to Define the Scope of Plaintiff's Waiver of the Attorney-Client Privilege and Motion to Compel Plaintiff To Produce Documents Improperly Withheld Based On The Attorney-Client Privilege

Considering first defendant's motion to "define the scope of the waiver of the attorney-client privilege," defendant argues that on June 21, 1998 and June 28, 1999, defendant served its first and second set of requests for production of documents on plaintiff; that in response thereto, plaintiff did not assert any objections based on the attorney-client privilege, disclose the existence of privileged documents, or produce a privilege log; that on

July 17, 2001, plaintiff produced a privilege log listing four (4) documents that pertain to Dorsey & Whitney; that on August 1, 2002, defendant deposed Gregory Sebald, the attorney from plaintiff's first law firm of Merchant & Gould; that during the deposition, Mr. Sebald testified that plaintiff's trademark files had been transferred from Merchant & Gould to Dorsey & Whitney; that on August 8, 2002, defendant subpoenaed plaintiff's trademark files from Dorsey & Whitney; that in response to the subpoena, Dorsey & Whitney produced a privilege log containing a list of 18 documents, none of which had been previously disclosed by plaintiff; that such documents should have been produced in response to defendant's first and second set of document production requests; that the documents are either not privileged or fall within the scope of plaintiff's waiver of the attorney-client privilege as described in the Board order dated May 8, 2002; and that the scope of plaintiff's waiver of the attorney-growing privilege extends to all communications on the same subject, and is not limited to plaintiff's communications with attorneys at Merchant & Gold.

In response, plaintiff argues that defendant's motion for clarification of the Board's May 8, 2002 order essentially amounts to an untimely request for reconsideration; and that in any event, the scope of the

waiver applies only to plaintiff's communications with Merchant & Gould attorney Gregory Sebald, and does not apply to any of the newly disclosed documents listed on plaintiff's or Dorsey & Whitney's privilege log.

To the extent that defendant is seeking clarification of the attorney-client privilege waiver described in the May 8, 2002 Board order, or requesting reconsideration thereof, defendant's motion is denied. The request for reconsideration is untimely. See Trademark Rule 2.127(b). Notwithstanding the untimeliness of the request, the Board order is clear and needs no further explanation. As stated in the order:

The voluntary waiver by a party, without limitation, of one or more privilege documents discussing a certain subject *waives the privilege as to all communications between the same attorney and the same client on the same subject.* The authorities for this general rule are numerous.

(emphasis added). Hence, the attorney-client privilege waiver is limited to plaintiff's communications with its former legal counsel at Merchant & Gould.

To the extent that defendant is seeking to extend the scope of the voluntary waiver described in the Board's May 8, 2002 order beyond plaintiff's communications with Merchant & Gould, the motion is denied. According to the record before us, the previously undisclosed communications now at issue appear to have taken place between legal

counsel from Dorsey & Whitney and plaintiff. The waiver does not extend to the subject matter of the voluntarily disclosed communications nor to plaintiff's former counsel at Dorsey & Whitney.

Furthermore, to the extent that defendant is arguing that because plaintiff failed to previously disclose the existence of these documents, plaintiff has waived the attorney-client privilege, the motion is denied.

In view of the foregoing, defendant's motion to compel the production of the previously undisclosed documents listed on the privilege log is denied.²

Defendant's Motion To Prohibit Mr. William Hardacker,
Plaintiff's Former Counsel, From Invoking The Attorney-
Client Privilege To Avoid Deposition

On July 2, 2002, defendant served William J. Hardacker, former legal counsel for plaintiff, with a subpoena issued from the U.S. District Court for the District of Minnesota for a deposition to take place on July 23, 2002. On July 16, 2002, Mr. Hardacker sent a notice of objection to the subpoena and refusal to attend on the grounds that any information he may have in relation to this proceeding is "privileged in accordance with the attorney-client privilege."

² Plaintiff may, however, be precluded from relying on these documents at trial pursuant to the estoppel sanction. See TBMP § 527.01(a) and authorities cited therein.

Defendant seeks a Board order prohibiting plaintiff from allowing Mr. Hardacker to invoke the attorney-client privilege to avoid deposition on several grounds, including that plaintiff allegedly waived the attorney-client privilege based on the Board's May 8, 2002 order.

In response, plaintiff argues that because Mr. Hardacker is a third party witness to this proceeding and has been served a deposition subpoena issued from the U.S. District Court for the District of Minnesota, the Board lacks jurisdiction to compel Mr. Hardacker to attend the deposition.

Plaintiff's argument is well-taken. If a proposed deponent residing in the United States is not a party, or a person who, at the time set for the taking of the deposition, is an officer, director, or managing agent of party, or person designated under Fed. R. Civ. P. 30(b)(6) or 31(a)(3) to testify on behalf of a party, the responsibility rests totally with the opposing party to secure the attendance of the proposed deponent. See Trademark Rule 2.120(b). If the proposed deponent is not willing to appear voluntarily, the opposing party must secure the deponent's attendance by subpoena pursuant to 35 USC § 24 and Fed. R. Civ. P. 45. The subpoena must be issued from the United States District Court in the federal judicial district where the deponent resides or is regularly

employed. If the person named in a subpoena compelling attendance at a discovery deposition fails to attend the deposition, or refuses to answer questions propounded at the deposition, the deposing party must seek enforcement from the U.S. District Court which issued to subpoena; the Board has no jurisdiction over such depositions. See TBMP § 404.03(b)(2) and authorities cited therein.

Thus, the Board has no authority to compel Mr. Hardacker to attend the deposition or rule on the merits of his objection regarding the attorney-client privilege. The proper forum would be the U.S. District Court of the District of Minnesota.

In view of the foregoing, defendant's motion to prohibit Mr. Hardacker from invoking the attorney-client privilege to avoid deposition and compel his attendance is denied.

Defendant's Motion to Determine the Sufficiency of Plaintiff's Responses to Requests for Admissions

Defendant has moved to test the sufficiency of plaintiff's responses to Admission Request Nos. 5-7, 13, 15, 18, 21, 24, 27, 30-31, and 69, on the grounds that the objections asserted thereto are improper, and asks that the Board order that the requests be either deemed admitted or that amended answers be served.

As a preliminary matter, we note that with respect to Admission Request No. 5, inasmuch as plaintiff has agreed to provide an amended response, defendant's motion is now moot.

With regard to Requests for Admission Nos. 6 and 7, essentially defendant has brought a motion to test the sufficiency of plaintiff's responses because it either disagrees with, or disputes the veracity of those responses. A motion to test the sufficiency of a response to an admission request is solely a test of the legal sufficiency of the response. See Fed. R. Civ. P. 36(a) and Trademark Rule 2.120(h); see also, TBMP § 524 and authorities cited therein. Disagreements regarding the veracity of such responses are matters to be determined at trial and are not properly the subject of a motion to test their sufficiency. In view thereof, defendant's motion to test the sufficiency of plaintiff's answers to Admission Request Nos. 6 and 7 is denied; plaintiff's answers are deemed sufficient.

Plaintiff's denial of Admission Request No. 13 is accompanied by the objection that because the admission request includes the term "trademark", it is an attempt to "impute to the Community sophistication in intellectual property matters." Plaintiff further argues that because "trademark" is not defined, plaintiff is "not required to assume that goods (items subject to a trademark) or services (items subject to a service mark) are at issue." The Board

finds plaintiff's logic disingenuous at best. In view thereof, defendant's motion to determine the sufficiency thereof is granted; plaintiff is ordered to provide an amended response to Admission Request No. 13, with the assumption that the term trademark refers to goods and/or services.

Requests for Admission Nos. 15, 18, 21, 24 and 27 ask plaintiff to admit that in certain years, it never "notified, in writing or verbally" defendant or any affiliated corporation of its claim to superior rights or prior use of the words "Treasure Island." Plaintiff has denied each admission request, on the grounds that the term "notified" is vague, and means "constructive notice." The Board finds plaintiff's interpretation implausible. The term "notified" is clearly modified by the wording "in writing or verbally" in each admission request. In view thereof, defendant's motion to determine the sufficiency thereof is granted; plaintiff is ordered to provide amended responses to Requests for Admission Nos. 15, 18, 21, 24 and 27 in accordance with the plain meaning of the words "notified, in writing or verbally," and not under its own contrived theory of "constructive notice."

Plaintiff objected to Admission Request No. 69 on the ground that it calls for an opinion. It is well established that a discovery request which requires a party to give an

opinion or contention that relates to facts or the application of law to facts is proper and not necessarily objectionable. See Fed. R. Civ. P. 33 (b), and *Johnston Pump/General Valve Inc. v. Chromalloy American Corporation*, 10 USPQ2d 1671 (TTAB 1988). In view thereof, plaintiff's objection is overruled; defendant's motion to test the sufficiency of Admission Request No. 69 is granted; and plaintiff is ordered to either admit or deny the admission request.

In view of the foregoing, plaintiff is ordered to provide amended responses, without objections or qualifications, to Admission Requests Nos. 5, 13, 15, 18, 21, 24, 27, and 69 fifteen (15) days from the mailing date of this order.

Defendant's Motion to Compel Supplemental Responses to Interrogatories

As a preliminary matter, we note that with respect to Interrogatory No. 5(b), inasmuch as plaintiff has agreed to provide an amended response, defendant's motion to compel is moot.

With regard to Interrogatory Nos. 1 and 6(f), essentially defendant has moved to compel supplemental responses because it is dissatisfied with the responses it has received. This cannot form the basis for motion to

compel. Accordingly, defendant's motion to compel is denied with respect to Interrogatory Nos. 1 and 6(f).

Plaintiff's response to Interrogatory No. 6(g) is based on its interpretation of the term "notified" as "constructive notice." Consistent with our discussion regarding the admission requests, defendant's motion to compel a supplemental response is granted with respect to Interrogatory No. 6(g); plaintiff must provide an amended response in accordance with the plain meaning of the words "notified, in writing or verbally."

With respect to Interrogatory No. 9, plaintiff's objection on relevancy grounds is well-taken. There is no infringement claim before the Board. In view thereof, defendant's motion to compel a supplemental response to Interrogatory No. 9 is denied.

In view of the foregoing, plaintiff is ordered to provide an amended response, without objections or qualifications, to Interrogatory No. 5(b) and 6(g) fifteen (15) days from the mailing date of this order.

Defendant's Motion to Compel Production of Documents

Defendant has moved to compel production of documents responsive to Document Request No. 1 of Set Three. Plaintiff has stated that it has provided all such documents. In view thereof, defendant's motion to compel the production of the aforementioned documents is moot.

The Board reminds the parties of the good faith effort requirements set forth in Trademark Rule 2.120 and *Sentrol, Inc. v. Sentex Systems, Inc.*, 231 USPQ 666 (TTAB 1986).

That is, the parties must cooperate with each other so that the case may proceed in an orderly manner within reasonable time constraints.

Plaintiff is also advised that if proper discoverable matter is withheld from the requesting party, then the responding party will be precluded from relying on such information and from adducing testimony with regard thereto during its testimony period. See *Shoe Factory Supplies Co. v. Thermal Engineering Company*, 207 USPQ 517 (TTAB 1980); and *Presto Products Inc. v. Nice-Pak Products Inc.*, 9 USPQ2d 1895, at n.5 (TTAB 1988).

Defendant's Motion to Extend Discovery

Defendant has moved to extend discovery in the consolidated cancellation proceedings,³ and plaintiff has indicated that it gave its verbal consent thereto.

Defendant's motion to extend discovery is granted, but only to a limited extent as noted below in the resetting of trial dates.

Both parties have taken extensive discovery in this proceeding. The parties have served and received responses to multiple sets of discovery requests. In addition, both

³ Discovery had closed in opposition proceeding No. 91115866.

parties have engaged in what can only be viewed as an unusually aggressive motion practice which has served only to delay the proceeding and increase the costs to both parties and the Board. In the event that either party continues to engage in such aggressive tactics, the Board may entertain several options, including sanctions pursuant to the Board's inherent authority or requiring a moving party to request permission before filing a motion before the Board. See *e.g. Carrini v. Carla Carini S.R.L.*, 57 USPQ2d 1067 (TTAB 2002).

Defendant's Failure to Renew Registrations

On April 20, 2004, the Board ordered defendant to show cause why the cancellation of the registrations involved in Cancellation Nos. 92028127, 19028314, and 92028319 under Section 8 of the Trademark Act should not be deemed to be the equivalent of a cancellation by request of respondent without the consent of the adverse party, and should not result in entry of judgment against respondent as provided by Trademark Rule 2.134(a). Plaintiff filed a response thereto, and defendant has filed a reply.⁴

Plaintiff has filed a request that the Board issue additional show cause orders for Cancellation Nos. 92028174,

⁴ The Board inadvertently issued the show cause orders separately for each proceeding instead of under the parent case, Opposition No. 91115866.

92028294, and 92028325 in light of the cancellation of the involved registrations under Section 8 as well.

Plaintiff's request is well-taken. **In view thereof, defendant is allowed until fifteen (15) days from the mailing date of this order to show cause why such cancellations in Cancellation Nos. 92028174, 92028294, and 92028325 should not be deemed to be the equivalent of a cancellation by request of respondent without the consent of the adverse party, and should not result in entry of judgment against respondent as provided by Trademark Rule 2.134(a).** In the absence of a showing of good and sufficient cause, judgment may be entered against respondent. See Trademark Rule 2.134(b).

If, in response to this order, respondent submits a showing that its failure to file a Section 8 affidavit was the result of inadvertence or mistake, judgment will not be entered against it.

In that case, petitioner will be given time in which to elect whether it wishes to go forward with the cancellation proceeding, or to have the cancellation proceeding dismissed without prejudice as moot. See *C. H. Guenther & Son Inc. v. Whitewing Ranch Co.*, 8 USPQ2d 1450 (TTAB 1988) and TBMP § 602.02(b).

In view of the foregoing, the Board defers consideration of defendant's response and plaintiff's reply

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with respect to Cancellation Nos. 92028127, 92028314, and 92028319.

Trial Dates Reset

Trial dates are reset as follows:

THE PERIOD FOR DISCOVERY IN
OPPOSITION NO. 91115866 TO CLOSE: CLOSED

THE PERIOD FOR DISCOVERY
IN CANCELLATION NOS. 92028126; 92028127;
92028130; 92028133; 92028145; 92028155;
92028171; 92028174; 92028199; 92028248;
92028280; 92028294; 92028314; 92028319;
92028325; 92028342; and 92028379
TO CLOSE: July 7, 2004

30-day testimony period for party in
position of plaintiff to close: October 5, 2004

30-day testimony period for party in
position of defendant to close: December 4, 2004

15-day rebuttal testimony period for
plaintiff to close: January 18, 2005

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b).

An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

New Developments at the Trademark Trial and Appeal Board

- Files of TTAB proceedings can now be examined using TTAB Vue, accessible at <http://ttabvue.uspto.gov>. After entering the 8-digit proceeding number, click on any entry in the prosecution history to view that paper in PDF format. Papers filed prior to January 2003 may not have been scanned. Unscanned papers remain available for public access at the TTAB. For further information on file access, call the TTAB at (703) 308-9330.
- Parties should also be aware of recent changes in the rules affecting trademark matters, including the rules of practice before the TTAB. See Rules of Practice for Trademark-Related Filings Under the Madrid Protocol Implementation Act, 68 Fed. R. 55,748 (September 26, 2003) (effective November 2, 2003) (www.uspto.gov/web/offices/com/sol/notices/68fr55748.pdf); Reorganization of Correspondence and Other Provisions, 68 Fed. Reg. 48,286 (August 13, 2003) (effective September 12, 2003) (www.uspto.gov/web/offices/com/sol/notices/68fr48286.pdf).
- The second edition (June 2003) of the Trademark Trial and Appeal Board Manual of Procedure (TBMP) has been posted on the USPTO web site at www.uspto.gov/web/offices/dcom/ttab/tbmp/.